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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/680,103

10/08/2003

Shigeyoshi Morita

8029-1056

4466

466 7590 11/24/2008

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EXAMINER

MCCORMICK, GABRIELLE A

ART UNIT

PAPER NUMBER

3629

MAIL DATE

DELIVERY MODE

11/24/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--|---|--|
| Office Action Summary | Application No. 10/680,103 | Applicant(s) MORITA, SHIGEYOSHI | |
| | Examiner Gabrielle McCormick | Art Unit 3629 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☒ Claim(s) 6-10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/8/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. This action is in reply to the amendment filed on September 5, 2008.
2. Claims 1 and 12 have been amended.
3. Claims 13 and 14 have been added.
4. Claims 1-14 are currently pending and have been examined.

Information Disclosure Statement

5. The Information Disclosure Statement filed on September 5, 2008 has been considered. An initialed copy of the Form 1449 is enclosed herewith.

Claim Objections

6. The previous objection to claim 1 is withdrawn as a result of Applicant's amendment.
7. Claim 6 is objected to for the apparent incorrect use of the verb "connects". The Examiner will understand the claim to mean "connecting to" rather than "connects". Claims 7-10 are objected to through their dependency to claim 6.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
9. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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10. Claim 1 recites "said address information for said personal information that was approved by said information server at the time when each of said users of said information communication terminals registered his/her personal information in said information server". It is unclear what information was approved by the server, i.e., address or personal. Further, the limitation of "a database in which said password and said personal information with said address information that said information server approved are stored" also is unclear as to what information was approved. Agreement between these two limitations is essential to understand the scope of the claim.
11. Claim 2 recites "wherein...a transmitting means" but does not recite what the transmitting means does. In other words, the limitation appears to lack a verb to describe the action of the transmitting means.
12. Claim 6 recites "said address information for said personal information that was approved by said information server at the time when each of said users of said information communication terminals registered said personal information in said information server". It is unclear what information was approved by the server, i.e., address or personal.
13. Claims 2-5 and 7-10 are rejected through their dependency from rejected claims 1 and 6.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. **Claims 1-12** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gehani et al. (US Pat. No. 5,918,009, hereinafter referred to as "Gehani") in view of Zeltzer et al. (US Pub. No. 2003/0182232, hereinafter referred to as "Zeltzer") in view of Shinzaki et al. (US Pub. No.

2003/0004881, hereinafter referred to as "Shinzaki") in view of Himmel et al. (US Pat. No. 6,212,522, hereinafter referred to as "Himmel").

16. Claims 1, 3, 5, 6, 8, 10 and 11: Gehani discloses

- *information communication terminals that are used by users; (C2; L 45-53)*
- *an information server in which personal information of said users are registered; (C2; L45-53 and C2; L31-44: map related information is shared with companions and thus contains letter and sign information.)*
- *a communication network that connects said information communication terminals to said information server, (C2; L45-53: "WWW") wherein:*
- *each of said information communication terminals, comprising:*
- *a personal information registering means that registers his/her personal information in said information server via said communication network (C4; L12-19) by using a password (C2; L54-64: "login identification" and "password") and attaching address information for said personal information; (C3; L36-60: "URL")*
- *a transmitting means for transmitting from a information communication terminal of said information communication terminals to an other information communication terminal of said information communication, said address information and said password; (C5; L9-14: user communicates login ID and password to companion through a secondary communication means such as text-chat)*
- *a receiving means for receiving on the other information communication terminal the transmitted said address information and said password from the information communication terminal; (C5; L14-20: companion receives information from user and accesses the URL using the user's login ID and password.) and*
- *an obtaining means for obtaining from said information server by said other information communication terminal, personal information by providing the information server the received said information address and said password (C5; L14-20: companion receives information from user and accesses the URL using the user's login ID and password.)*

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- *said information server, comprising: said password and said personal information with said address information that said information server approved are stored, (C2; L65 – C3; L10: the login ID (i.e., personal information) and password are verified by checking against the stored copies in computer 115 and "memory space associated with the user's login ID".)*
17. Gehani does not explicitly disclose *a memorizing means that memorizes said password for connecting to said information server and said address information for said personal information that was approved by said information server at the time when each of said users of said information communication terminals registered his/her personal information in said information server or a database.*
18. Zeltzer, however, discloses storing bookmarked information (i.e., a URL) on a wireless device to be used for direct transmission. (P[0058] and [0067]) Further, a user enters a username and password to access the URL (P[0061]). A central server with a database for storing information is disclosed. (P[0026]).
19. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included storing URL on a device and information in a database, as disclosed by Zeltzer in the system disclosed by Gehani, for the motivation of providing a method of a method of sharing information. Gehani shares information between users on personal computers via a web-based server. The PDA taught by Zeltzer is a form of personal computer, therefore it is obvious to expand Gehani to include the user of PDAs to share information as they are capable of data transmission and therefore perform the task of communicating information between users. The storing of data on the PDA enables transmission of information between devices. It is old and well known that PDA's are capable of sending information to another PDA. Gehani would be motivated to use PDAs as a convenient means of sharing data. Gehani would also be motivated to expand its system to include storing information in a database because it is obvious to store registration information (such as provided in C2; L60-64) in a database for organization and ease of retrieval.

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20. Shinzaki discloses the use of PDAs (P[0005]) and storing passwords in the personal information terminal (i.e., a PDA) for the user's convenience. (P[0009]).
21. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included storing a password on a device, as disclosed by Shinzaki in the system disclosed by Zeltzer, for the motivation of providing convenience to the user such that the user does not need to remember a variety of passwords.
22. Himmel discloses a system where a user creates bookmarks for dissemination to others. (C6; L15-21). Part of the system requires that tests are run of the URLs to ensure that information is entered correctly and that the URLs point to active web pages. (C7; L54-57). The server must be satisfied that the bookmark set (i.e., the URLs) meet desired criteria before the set is available to others. (C8; L11-13) Thus, the URLs are approved by the server.
23. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included address information approval, as disclosed by Himmel, in the system of Gehani for the motivation of ensuring that the syntax for defining a network connection is correct and points to an active web page. (Himmel; C1; L43-45 and C7; L54-57).
24. **Claims 2 and 7:** Gehani discloses "ROUTE PLANNER option 603 can be select to plan another route." (C5; L1-2), as well as MAPS, ROUTES and YELLOW PAGES options (C3; L18-30). Thus, it is inherent that each route would have a different URL approved and stored by the server and that user would transmit the URL and password of the selected route to the companion. (C5; L10-20). As combined above with Himmel, the URLs would be approved to ensure that each points to an active web page. (Himmel; C7; L54-57).
25. Zeltzer has disclosed, as discussed in claims 1 and 6, the information communication terminals memorizing address information.
26. **Claims 4, 9 and 12:** Gehani does not disclose radio or infrared signals.
27. Zeltzer, however, discloses IrDA (P[0057]). The Examiner takes **Official Notice** that short distance radio communication, such as RFID, is an old and well known form of wireless

communication and Zeltzer's disclosure of a wireless device for communication purposes would obviously include the use of short distance radio communication.

28. **Claims 13-14** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gehani et al. (US Pat. No. 5,918,009, hereinafter referred to as "Gehani") in view of Zeltzer et al. (US Pub. No. 2003/0182232, hereinafter referred to as "Zeltzer") in view of Shinzaki et al. (US Pub. No. 2003/0004881, hereinafter referred to as "Shinzaki") in view of Himmel et al. (US Pat. No. 6,212,522, hereinafter referred to as "Himmel") in further view of Setchell. ("Hotjobs; [2 Edition]". The Press. Christchurch, New Zealand: Nov 17, 2001. pg. YC.2.).
29. **Claims 13 and 14:** Gehani discloses that information particular to the user is stored (C3; L6-7), but does not disclose that personal information comprises a name, a web page or an occupation.
30. Setchell, however, discloses creating and storing online resumes that are displayed with its own URL. (pg. 1; para. 13).
31. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included a name, URL and occupation, as disclosed by Setchell, in the system of Gehani for the motivation of sharing various types of personal data with others. It is obvious to expand Gehani to share data with others beyond just planning a route.
32. Further, these differences are only found in the **nonfunctional descriptive data** and are not functionally involved in the steps recited. **The sharing of information would be performed regardless of particulars of the information, such as a name, URL or occupation.** Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).
33. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included a name, URL and occupation because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation personal information does not patentably distinguish the claimed invention.

Response to Arguments

34. Applicant's arguments, see Remarks, pages 12-14, filed September 5, 2008, with respect to the rejection(s) of claim(s) 1, 2, 6 and 11 under Gehani in view of Zeltzer have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in further view of Shinzaki and Himmel.
35. The Examiner notes that Applicant did not traverse the Official Notice taken with regard to claims 4, 9 and 12. Thus, the use of short distance radio communication is taken to be prior art.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gabrielle McCormick whose telephone number is (571)270-1828. The examiner can normally be reached on Monday - Thursday (5:30 - 4:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/G. M./
Examiner, Art Unit 3629

/John G. Weiss/

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Supervisory Patent Examiner, Art Unit 3629